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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,200	09/08/2003	Hideo Toyofuku	50099-237	7481
7590 05/12/2008 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. WASHINGTON, DC 20005-3096				
EXAMINER DICKER, DENNIS T				
ART UNIT		PAPER NUMBER		
2625				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/656,200

**Applicant(s)**

TOYOFUKU ET AL.

**Examiner**

DENNIS DICKER

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-7, 9, 11, 13 and 15-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 5-7, 9, 11, 13, 15-19 is/are rejected.  
7) ☒ Claim(s) 3 and 4 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Response to Arguments*

2. Applicant's arguments, see Pages 9-1 of Remarks filed 4/2/2008, with respect to the rejection(s) of claim(s) 1, 7, 9, 11 and 13 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sato et al.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7, 9, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi (hereinafter "Hiroshi '2A2" EP 838342A2) in view of Sato et al (hereinafter "Sato '146" US 2003/0070146).

With respect to **Claim 1**, Hiroshi '2A2 teaches a printing system comprising:

(a) a printing machine having a plurality of paper feed sections (**i.e., A plurality of paper feed sections are included in the printer, Col. 3 Lines 40-45**), said printing machine using a sheet stored in any one of said plurality of paper feed sections (**i.e.,**

**Col. 3 Lines 45-49, sheets can be stored into a paper feed section and used for printing ); and a controller for providing print data to said printing machine (i.e., Col. 2 Lines 48-55 , Host computer providing print data to printer), said controller including a paper feed section specifying element (i.e., Col. 7 lines 16-17 , sheet feed controller) for specifying one of said plurality of paper feed sections for feeding said sheet for printing of an image represented by said print data on said sheet (i.e., Col. 7 Lines 14-17, sheet feed controller gives instructions to specify the sheet feed mechanism to select a specific sheet path for feeding a sheet for a image to be printed on), an information defining element (i.e., Col. 5 Line 9, print customizer) for defining identification information(i.e., Col. 5 Lines 9-10, Print customizer defines a sheet that was fed in the printer by the specific sheet path) that is used to create a preview image for identifying said plurality of paper feed sections. (i.e., Col. 5 lines 11-15, Specific sheets that were defined by the print customizer are previewed on a monitor).**

Hiroshi '2A2 does not explicitly teach an image creating element for creating a preview image, based on said image represented by said print data, and said identification information defined by said information defining element for the paper feed section specified by said paper feed section specifying element, a display element for displaying said preview image created by said image creating element and a position specifying element for specifying a position in which a slip sheet is to be inserted between printed sheets; and a slip sheet feed section specifying element for specifying one of said plurality of paper feed sections for feeding a sheet to be used as said slip

sheet; and said image creating element creates said preview image, based on said position in which said slip sheet is to be inserted which is specified by said position specifying element, and said identification information defined by said information defining element for said paper feed section specified by said slip sheet feed section specifying element.

However, the mentioned claimed limitations are well known in the art as evidenced by Sato '146. In particular, Sato '146 teaches the use of an image creating element for creating a preview image (**i.e., Para 0167 and Fig. 28, Preview image is created**), based on said image represented by said print data, and said identification information defined by said information defining element for the paper feed section (**i.e., Para 0167 and Fig. 28, preview image based on attributes as shown in Fig. 4b**) specified by said paper feed section specifying element (**i.e., Para 0072 and Fig. 4b and , slip sheet attribute includes designation of inserting a paper sheet from a paper feed section**), a display element for displaying said preview image created by said image creating element (**i.e., Fig. 28 , print preview display showing inserted sheets**) and a position specifying element for specifying a position in which a slip sheet is to be inserted between printed sheets (**i.e., Para 0072 and Para 0106, The "slip sheet" attribute includes designation of a sheet feed source when a slip sheet is inserted** ) ; and a slip sheet feed section specifying element for specifying one of said plurality of paper feed sections for feeding a sheet to be used as said slip sheet (**i.e., Para 0072 and Fig. 4b and , slip sheet attribute includes designation of inserting a paper sheet from a paper feed section from an inserter or sheet fee cassette**), and

said image creating element creates said preview image, based on said position in which said slip sheet is to be inserted which is specified by said position specifying element, and said identification information defined by said information defining element for said paper feed section specified by said slip sheet feed section specifying element (i.e., **Fig. 28, Para 0072 and 0167, creating element creates a preview image based on specified position and identification information for paper feed section for a slip sheet).**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the printing system of Hiroshi '2A2 as taught by Sato '146 since Sato '146 suggested in Para 0111 that such a modification would provide and improved information processing apparatus that comprises a tab setting means for effectively setting information about a tab of an insertion paper sheet to be inserted between predetermined pages of document information.

With respect to **Claim 6**, Hiroshi '2A2 teaches a printing system wherein said display element (i.e., **Col. 5 Lines 28, GUI**) displays a plurality of preview images created by said image creating element in list form (i.e., **Col 5 Lines 11-19 and Fig. 3, GUI displays in list form a preview image created by a image creating element such as a print customizer a list of preview images).**

With regards to the controller of **Claim 7**, the limitation of the claim 7 are corrected by limitation of claim 1 above. The steps of claim 7 read into the function step of claim 1.

With regards to the method of **Claim 9**, the limitation of the claim 9 are corrected by limitation of claim 1 above. The steps of claim 9 read into the function step of claim 1.

With regards to the recording medium of **Claim 11**, the limitation of the claim 11 are corrected by limitation of claim 1 above. The steps of claim 11 read into the function step of claim 1.

With regards to the program product of **Claim 13**, the limitation of the claim 13 are corrected by limitation of claim 1 above. The steps of claim 13 read into the function step of claim 1.

4. Claims 5 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi '2A2 and Sato '146 as applied to claim 1 above, and further in view of Shibasaki (hereinafter Shibasaki '352"US 2002/0054352).

With respect to **Claim 5**, the combination of Hiroshi '2A2 and Sato '146 does not explicitly teach printing system where the identification information is defined a pattern of said preview image.

However, the mentioned Claimed limitations are well known in the art as evidenced by Shibasaki '352, In particular Shibasaki '352 teaches a printing system where the identification information is defined as a pattern of said preview image (**i.e., Identification information as shown in 22a of fig. 9 can be defined as a pattern of said preview image as shown in 31a of fig. 10).**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the printing system of Hiroshi '2A2 and Sato

'146 as taught by Shibasaki '352 since Shibasaki '352 suggested in Para 0012 that such a modification would provide a system for image formation where a user can easily carry out setting and combination of original images as the user intended.

With respect to **Claim 15**, The combination of Hiroshi '2A2 and Sato '146 does not explicitly teach a printing system wherein said image creating element creates said preview image based on an image composed of said identification information and said image.

However, the mentioned Claimed limitations are well known in the art as evidenced by Shibasaki '352. In particular, Shibasaki '352 teaches the use of a printing system wherein said image creating element creates said preview image (**i.e., Para 0026, Preview image displayed on a preview image**) based on an image composed of said identification information (**i.e., Fig. 7, Identification information is scanned in and represented as 22a**) and said image (**i.e., Para 50 and Fig. 7, Image is inputted as data file 1 and represented as 21a**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the printing system of '2A2 and Sato '146 '530 as taught by Shibasaki '352 since Shibasaki '352 suggested in Para 0012 that such a modification would provide a system for image formation where a user can easily carry out setting and combination of original images as the user intended.

With regards to the controller of **Claim 16**, the limitation of the claim 7 are corrected by limitation of claim 15 above. The steps of claim 16 read into the function step of claim 15.



With regards to the method of **Claim 17**, the limitation of the claim 17 are corrected by limitation of claim 15 above. The steps of claim 17 read into the function step of claim 15.

With regards to the recording medium of **Claim 18**, the limitation of the claim 18 are corrected by limitation of claim 15 above. The steps of claim 18 read into the function step of claim 15.

With regards to the program product of **Claim 19**, the limitation of the claim 19 are corrected by limitation of claim 15 above. The steps of claim 19 read into the function step of claim 15.

***Allowable Subject Matter***

1. Claim 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: none of the references, either singularly or in combination, teach or fairly suggest a printing System comprising a printing, controller an information defining element, paper feed section, image creating element and a display element where the image creating element creates a preview image by identification specified by paper feed specifying element as a background and periphery of preview image.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS DICKER whose telephone number is (571)270-3140. The examiner can normally be reached on Monday -Thursday 7:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Twyler Haskins  
Examiner  
Art Unit 2625

/D. D./  
Examiner, Art Unit 2625  
5/9/2008

/Twyler L. Haskins/  
Supervisory Patent Examiner, Art Unit 2625